

REMARKS

Claims 1-77 are pending in the present application. Claims 25-45 and 64-77 were previously withdrawn from consideration as drawn to a non-elected invention. By virtue of this response, claims 1 and 46 have been amended and new claim 78 has been added. No claims have been cancelled, and no new matter has been added. Accordingly, claims 1-24, 46-63, and 78 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Claim Rejections under 35 U.S.C. §102(b)**Claims 1-16, 20-24, 46-56, and 61-63**

Claims 1-16, 20-24, 46-56, and 61-63 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Pat. No. 4,140,130 to Storm III ("Storm"). In order to anticipate a claim under 35 U.S.C. §102(b), a reference must teach each and every element recited by that claim. Here, independent claims 1 and 46, from which the remaining rejected claims depend, have been amended to recite that the microwave antenna "comprises a distal tip configured to penetrate tissue." Storm fails to teach or disclose this element. First, Storm does not have a microwave antenna comprising a "distal tip." Second, as evidenced by the description and figures, Storm's device is adapted to be placed on the outside of the body (and not to penetrate it).

Accordingly, Applicants submit that claims 1-16, 20-24, 46-56, and 61-63 are novel in view of Storm and respectfully request that the outstanding rejection of these claims under 35 U.S.C. §102(b) be withdrawn.

Claim Rejections under 35 U.S.C. § 103(a)**Claims 17-19 and 57-60**

Claims 17-19 and 57-60 stand rejected variously under 35 U.S.C. §103(a) as unpatentable over Storm as a primary reference, in view of U.S. Pat. No. 5,829,519 to Uthe (claims 18 and 57-60), U.S. Pat. No. 5,281,217 to Edwards (claim 17), and U.S. Pat. No. 5,964,755 to Edwards (claim 19). In order to establish a *prima facie* case of obviousness, three conditions must be met. First, the references must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation to modify the references or combine their teachings, and third, there must be a reasonable expectation of success, *see* MPEP §2143.

Applicants submit that the Office Action fails to set forth a *prima facie* case of obviousness for any of the above rejected claims, for at least the reason that the art relied upon fails to teach or suggest all the claim limitations. Specifically, the art fails to teach or suggest a microwave antenna that “comprises a distal tip configured to penetrate tissue.” Storm, the primary reference was discussed in detail above where it was described that Storm fails to teach or disclose this element. Uthe, and both of the Edwards patents relied upon fail to cure this deficiency.

Therefore, for at least the reason that each and every element has not been shown, and hence a *prima facie* case of obviousness has not been established, Applicants submit that the outstanding rejection of claims 17-19, and 57-60 under 35 U.S.C. §103(a) should be withdrawn.

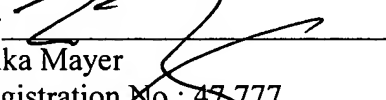
CONCLUSION

Applicants have, by way of the amendments and remarks presented herein, made a sincere effort to overcome rejections and address all issues that were raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims is respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 412692001700. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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